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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,147	05/30/2001	Toshiaki Tsuboi	10746/26	8853
26646	7590	06/01/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/870,147

Applicant(s)

TSUBOI ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 May 2006 has been entered.

2. This communication is in response to the Request for Continued Examination and amendment filed on 15 May 2006. Claims 1, 9, 17 have been amended. Claims 1-17 remain pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 7, 9-11, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580 for substantially the same reasons given in the

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previous Office Action (paper number 020706), and further in view of Cairnes, U.S. Patent Number 6, 139, 494. Further reasons appear hereinbelow.

(A) Claim 17 has been amended to recite

- “an obtaining operation” in line 4;
- “a reading operation of reading” a scenario “from a storing part of the health practitioner support apparatus, wherein said storing part stores scenarios” in lines 6-7;
- “a preparing operation” ... “that is read from said storing part in said reading operation” ... “that is obtained in said obtaining operation” in lines 10-12; and
- “an outputting operation” in line 14;

As per newly amended claim 17, Strecher teaches a method of supporting health promotion for preventing diseases caused by lifestyles and for promoting and maintaining health by using a health promotion practitioner support apparatus, said method comprising:

a “collecting” or “gathering” (reads on “obtaining”) operation of obtaining data on lifestyles (Strecher; column 2, lines 12-30) and a level of readiness for change of a client (Strecher; column 4, lines 22-26); Examiner interprets Strecher’s teachings of “[d]uring the preparation phase, motives cited by the user are also analyzed and incorporated into the algorithm, which provides instructions intended to internalize motives for changing” as teaching obtaining data on a level of readiness for change of a client.

Although Strecher teaches obtaining a scenario which includes health promotion information and health promotion timing for each of levels of readiness for change (Strecher; column 2, line 53 to column 3, line 5, column 4, lines 5-31); (Examiner interprets Strecher’s

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teachings of collecting data “about the pattern and history of the health-related behavior” as a “scenario);” and preparing a health promotion schedule of said client from said scenario and said data, and outputting said health promotion schedule (Strecher; column 3, lines 5-12, column 3, line 61 to column 4, line 3); and outputting “feedback” (reads on “health promotion information for said client according to operation to said health promotion schedule”),

Strecher fails to explicitly disclose

a reading operation of reading a scenario from a storing part of the health practitioner support apparatus, wherein said storing part stores scenarios each of which includes health promotion information and health promotion timing for each of levels of readiness for change; and

a preparing operation of preparing a health promotion schedule of said client using said scenario that is read from said storing part in said reading operation and said data that is obtained in said obtaining operation, and outputting said health promotion schedule; and

an outputting operation of outputting health promotion information for said client according to operation to said health promotion schedule.

However, the above features are well-known in the art, as evidenced by Cairnes.

In particular, Cairnes teaches

a reading operation (Cairnes; Figure 13, column 15, lines 55-59) of reading an “outpatient case summary” (reads on “a scenario”) from a “database” (reads on “storing part”) of the health practitioner support apparatus, wherein said storing part (Cairnes; Figure 13, column 15, lines 52-54) stores “outpatient case summaries” (reads on “scenarios”) each of which includes health promotion information and health promotion timing for each of levels of

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readiness for change (Cairnes; column 6, lines 33-35, column 11, lines 24-32, column 15, lines 44-52); and

a preparing operation of preparing a health promotion schedule of said client using said scenario that is read from said storing part in said reading operation and said data that is obtained in said obtaining operation, and outputting said health promotion schedule (Cairnes; Figure 16, Item 1004, column 17, lines 24-41); and

an outputting operation of outputting health promotion information for said client according to operation to said health promotion schedule (Cairnes; Figure 17, Items 1106, 1108, column 18, lines 43-46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Strecher to include these limitations, as taught by Cairnes, with the motivations of providing a system that “enables care to be vastly improved by providing quality tele-informatics for effective sign and symptom surveillance, adherence monitoring and support, medications management, patient education and reinforcement, holistic patient care, timely responsiveness to changing conditions, care based on varying clinical need over long time periods through clinical case management and therapy integration” (Cairnes; column 1, lines 56-64).

(B) Apparatus claim 1 repeats the subject matter of claim 17, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 17 have been shown to be obvious in view of the combined teachings of Strecher and Cairnes in the above rejections of claim 17, it is readily apparent that the system disclosed by Strecher and Cairnes includes the

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apparatus to perform these functions. As such, these limitations are rejected of the same reasons given above for method claim 17, and incorporated herein.

(C) Claim 9 differs from method claim 17 by reciting a “computer readable medium storing program code...” in the preamble and “program code” recited in a “means plus function” format in the limitations. As per these limitations, Strecher clearly discloses his invention to be implemented on a computer readable medium storing program code (Strecher; column 4, lines 58-60, column 5, lines 24-29). The remainder of claim 9 repeats the limitations of claim 17, and is therefore rejected for the same reasons given above for claim 17.

The motivations for combining the respective teachings of Strecher and Cairnes are as given in the rejection of claim 17 above, and incorporated herein.

(D) As per claims 2, 10, Strecher and Cairnes teach an apparatus and medium as analyzed and discussed in claims 1 and 9 above,

said part and said program code means for obtaining data comprising: a part and program code means for outputting information used for interviewing said client (Strecher; column 2, lines 39-57); and

a part and program code means for receiving responses of said client (Strecher; column 2, lines 24-29).

(E) As per claims 7, 15, Strecher and Cairnes teach an apparatus and medium as analyzed and discussed in claims 1 and 9 above

further comprising: a part storing plurality of kinds of health promotion information, said plurality of kinds of health promotion information including interview health promotion information, telephone health promotion information, and documents to be “provided to the user” (reads on “sent physically or by electronic mail”) (Strecher; column 2, lines 13-24, 60-62, column 4, lines 5-26, 34-48); and

wherein said part outputting health promotion information outputs said health promotion information by means suitable for one of said kinds of health promotion information (Strecher; column 2, lines 13-24, 60-62, column 4, lines 5-26, 34-48, column 5, lines 27-38).

(F) As per claims 3, 11 Strecher and Cairnes teach an apparatus and medium as analyzed and discussed in claims 2 and 10 above, said part outputting information used for interviewing said client comprising:

a part outputting question information for checking said level of readiness for change (Cairnes; column 11, lines 21-32); and

a part determining said level of readiness for change according to a response to said question information and determining information to be output hereafter according to said level of readiness for change (Cairnes; column 11, lines 21-32);

wherein said health promotion practitioner support apparatus determines said health promotion information according to responses of said client (Cairnes; Figure 17, column 11, lines 21-32, column 18, lines 43-46).

5. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580 and Cairnes, U.S. Patent Number 6, 139, 494, as applied to



claims 1 and 9 above, and further in view of Rieger et al. article: "Development of an Instrument To Assess Readiness to Recover in Anorexia Nervosa." 2000. URL: <<http://www3.interscience.wiley.com/cgi-bin/fulltext/74000261/PDFSTART>>, hereinafter known as Rieger, for substantially the same reasons given in the previous Office Action (paper number 020706). Further reasons appear hereinbelow.

(A) As per claims 4, 12, Strecher and Cairnes teach an apparatus and medium as analyzed and discussed in claims 1 and 9 above.

Strecher and Cairnes fail to explicitly disclose wherein said levels of readiness for change include an unconcerned stage, a precontemplation stage, a contemplation stage and a preparation stage.

However, Rieger teaches wherein said levels of readiness for change include an unconcerned stage (Examiner interprets Rieger's teaching of "*no thought of changing*" (Rieger; page 389, last paragraph) as reading on "unconcerned stage"), a precontemplation stage, a contemplation stage and a preparation stage (Rieger; page 389, last paragraph to page 391, first paragraph).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus and medium of Strecher to include these limitations, as taught by Rieger, with the motivations of increasing the effectiveness of interventions designed to enhance motivation since "readiness to change predicts aspects of behavioral and attitudinal change" (Rieger; page 395, paragraph 4, page 388, paragraph 4).

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6. Claims 5-6, 8, 13-14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580 and Cairnes, U.S. Patent Number 6, 139, 494, as applied to claims 1 and 9 above, and further in view of Douglass et al., U.S. Patent Number 6, 039, 688, for substantially the same reasons given in the previous Office Action (paper number 020706). Further reasons appear hereinbelow.

(A) As per claims 5, 13, Strecher and Cairnes teach an apparatus and medium as analyzed and discussed in claims 1 and 9 above

wherein: said health promotion schedule is displayed as a screen of a calendar format on a display part of said health promotion practitioner support apparatus or on a terminal which can access said health promotion practitioner support apparatus (Strecher; Figure 1, Figure 5, Figure 5, column 2, lines 53-59, column 6, lines 1-12).

Strecher and Cairnes fail to explicitly disclose

a number of clients is displayed in each day of the calendar format if said clients should receive health promotion on said day, and health promotion details are displayed for each of said clients by selecting said day.

However, the above features are well-known in the art, as evidenced by Douglass.

In particular, Douglass teaches

a number of clients is displayed in each day of the calendar format if said clients should receive health promotion on said day, and health promotion details are displayed for each of said clients by selecting said day (Douglass; Figure 60, column 8, lines 55-64, column 9, line 50 to column 10, line 60, column 18, lines 26-64, column 21, lines 41-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus and medium of Strecher and Cairnes to include these limitations, as taught by Douglass, with the motivations of providing a therapeutic program that could effectively motivate patients to modify their behavior and change their lifestyles to prevent or recover from ailments, and to enable physicians and their staffs to receive frequent feedback regarding patients' compliance with their programs (Douglass; column 1, line 61 to column 2, line 2).

(B) As per claims 6, 8, 14, 16, Strecher, Cairnes and Douglass teach an apparatus and medium as analyzed and discussed in claims 1, 5, 9, 13 above

wherein data for forming said health promotion schedule includes histories of provided health promotion (Strecher; column 2, lines 42-52), and further comprising:

a part obtaining results of medical examination or tests (Douglass; column 2, lines 35-39); and

a part selecting clients for preventing a specific disease by using said results (Douglass; column 2, lines 35-46).

The motivations for combining the respective teachings of Strecher, Cairnes and Douglass are as given in the rejections of claims 17 and 5 above, and incorporated herein.

### ***Response to Arguments***

7. Applicant's arguments filed 15 May 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 15 May 2006.

(A) At page 7 of the 15 May 2006 response, Applicant requests acknowledgement that Applicant's Drawings, filed 30 May 2001, are accepted. Examiner hereby acknowledges this acceptance.

(B) Applicant's arguments on pages 7-11 of the response filed 15 May 2006 with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Baruch et al., U.S. Patent Application Publication Number 2002/0077849, Welnicki et al., U.S. Patent Application Publication Number 2002/0073005, Brown et al., U.S. Patent Number 5, 879, 163, Byerly et al., U.S. Patent Number 6, 067, 524, Joao, U.S. Patent Application Publication Number 2001/0032099, and Rovinelli et al., U.S. Patent Number 6, 978, 244 teach the environment of promoting health.

9. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

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For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. After Final communications should be labeled "Box AF."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.
11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

May 25, 2006



JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER